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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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LY, CHEYNE D

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/038,854	SPYTEK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cheyne D Ly	1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-63 is/are pending in the application.
- 4a) Of the above claim(s) 48,53,54,56,58,60 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-47,49-52,55,57,59,61 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 42-63 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4/02; 5/03</u> | 6) <input type="checkbox"/> Other:  |

### **DETAILED ACTION**

1. Applicant's election with traversal of Group II, claims 5-13, SEQ ID NO. 38, filed August 20, 2003, is acknowledged.
2. The traversal is directed to cancelled claims which causes Applicant's argument to be moot.
3. The requirement is still deemed proper and is therefore made FINAL.
4. The addition of claims 42-63 has been acknowledged.
5. Claims 48, 53, 54, 56, 58, 60, and 62 are withdrawn due to said claimed not being directed to the elected Group II or SEQ ID NO. 38.
6. Specific to claim 48, the claimed subject matter wherein the critical limitation is a cell while the critical limitation of the elected subject matter a nucleic acid molecule.
7. Specific to claims 53, 54, 56, 58, 60, and 62, the limitation of coding variants wherein the specific amino acid residues are different from the elected SEQ ID NO. 38 causes the said claims to be directed non-elected subject matter.
8. Claims 42-47, 49-52, 55, 57, 59, 61, and 63 are examined on the merits.

### **IDS**

9. Document C279, filed April 11, 2002, has not been considered due to said document is not published.

### **CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

11. Claims 45, 53, 54, 56, 58, 60, and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Specific to claim 45, the term “complement” causes said claim to be vague and indefinite because it is unclear what criteria are being used to determine a nucleic sequence is complementary to the sequence of SEQ ID NO. 37. Is a complement of 2 nucleotides sufficient to consider the claimed nucleotide sequence complementary? Clarification of the metes and bounds of the instant claims is required.

13. Claims 53, 54, 56, 58, 60, and 62, line 1, recite the limitation sSNP, which causes the claims to be vague and indefinite. Abbreviations in claims are vague and indefinite unless accompanied by the full name, usually in parentheses.

14. Claims 53, 54, 56, 58, 60, and 62, line 1, recite the limitation “a cSNP and coding variant of the polynucleotide of claim 42 which encodes a serine at amino acid residue” causes the claims to be vague and indefinite because it is unclear which sequence, cSNP or coding variant, encodes the specified amino at the specific position. Clarification of the metes and bounds of the claims is required.

#### **LACK OF UTILITY UNDER 35 U.S.C. § 101**

15. The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, “Written Description” Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

16. The examiner is using the following definitions in evaluating the claims for utility.

"Specific" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

17. Claims 42-47, 49-52, 55, 57, 59, 61, and 63 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility.

18. The critical limitation of claims 42-47, 49-52, 55, 57, 59, 61, and 63 is the claimed polynucleotide encoding polypeptide SEQ ID NO: 38. The claimed nucleic acid is not supported by a specific asserted utility because the other disclosed uses (not specified for any particular sequence) mentioned in the specification are generally applicable to many nucleic acids. The specification states that the polynucleotide sequences encoding their respective polypeptides may be useful for preventing, treating, or ameliorating medical conditions listed on page 7; or screening for molecules (page 6-7). The above-mentioned list of desirable utility for the claimed

sequence falls short of a readily available utility. These are non-specific uses that are applicable to nucleic acids in general and not particular or specific to the polynucleotide being claimed.

19. Further, the claimed polynucleotide is not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, a nucleic acid may be utilized to obtain a protein. The protein could then be used in conducting research to functionally characterize the protein. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case, the protein produced as a final product resulting from processes involving the nucleic acid does not have asserted or identified specific and substantial utilities. Identifying and studying the properties of a protein itself or the mechanisms in which the protein is involved, such as the TEN-M3-like protein, does not define a “real world” context for use. Similarly, the other listed utilities and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to many such compounds.

20. Applicant discloses NOV15b polypeptide (SEQ ID NO:38) seems to be a Type II (Ncyt Cexo) membrane protein and it is a TEN-M3-like protein because of 87% identical to the *M. musculus* mRNA for Ten-M3 sequence as determined by a sequence search against the GenBank database. It is noted that applicant has identified a sequence which is known in the prior art and which has a stated sequence similarity to the claimed sequence. Absent factual evidence, one skilled in the art would have reason to doubt that sequence similarity alone would reasonably support the assertion that the biological activity of the claimed subject matter would be the same as that of the similar sequence. Furthermore, it is unclear whether the similar sequence identified

in the prior art has actually been tested for the biological activity or whether this also is an asserted biological activity based upon sequence similarity to yet a different sequence.

21. Note that it would have been well known in the art that sequence similarity does not reliably correlate to structural similarity and that structural similarity does not reliably result in similar or identical biological activities. For example, it would have been well known that even a single nucleotide or amino acid change or mutation can destroy the function of the biomolecule in many instances, albeit not in all cases. In the absence of factual evidence characterizing the structural and functional components of the biomolecule, the effects of these changes are largely unpredictable as to which ones will have a significant effect and which ones will be silent mutations having no effect. Several publications document the unpredictability of the relationship between sequence, structure, and function, although it is acknowledged that certain specific sequences have been found to be conserved in biomolecules having related function following a significant amount of further research. See Lopez et al. (Molecular Biology, 32:881-891, 1999); Attwood (Science, 290:471-473, 2000); Gerhold et al. (BioEssays, 18(12):973-981, 1996); Wells et al. (Journal of Leukocyte Biology, 61(5):545-550, 1997); and Russell et al. (Journal of Molecular Biology, 244:332-350, 1994). However, this level of factual evidence is absent here

#### **Claims Rejected Under U.S.C. § 112, First Paragraph**

22. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

### **LACK OF ENABLEMENT**

23. Claims 42-47, 49-52, 55, 57, 59, 61, and 63 are rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the claimed sequence. For a sequence putatively assigned a biological function, even if correct, does not appear to be defined as to what use it is to be applied to. The significance of the sequence is undefined, further rendering it indiscernible how someone of skill in the art would use such an entity.

24. The claimed invention is not supported by a specific, substantial, and credible utility or a well-established utility for the reasons set forth above (refer to 35 U.S.C. § 101 rejection), one skilled in the art would not know how to use the claimed invention.

### **LACK OF WRITTEN DESCRIPTION**

25. Claim 45 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

26. The specification discloses SEQ ID NO: 37 encoding the polypeptide of SEQ ID NO. 38. Claim 45 is directed to sequences that complement the sequence of SEQ ID NO: 37. None of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or



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she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

27. With the exception of SEQ ID NO: 37, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

*University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: "...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that 'the inventor invented the claimed invention.'" *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

28. Therefore, only SEQ ID NO: 37 but not the full breadth of the claim 45 meet the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115.)

### **CLAIM REJECTIONS - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 45 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by The Sigma Catalog (1990).

3. The above publication discloses a nucleic acid sequence (Product Number O 4253), which is complementary to the polynucleotide sequence of SEQ ID NO. 37 at position 1-3, as in instant claim 45.

### **CONCLUSION**

4. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 872-9306.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

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7. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly  
11/28/03

  
ARDEN H. MARSCHELL  
11/28/03